FEB 14 2003

No. 02-428

In the Supreme Court of the United States

DASTAR CORPORATION, PETITIONER

v.

TWENTIETH CENTURY FOX FILM CORPORATION, ET AL.

ON WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE NINTH CIRCUIT

BRIEF FOR THE UNITED STATES AS AMICUS CURIAE SUPPORTING PETITIONER

THEODORE B. OLSON
Solicitor General
Counsel of Record

ROBERT D. MCCALLUM, JR.
Assistant Attorney General

PAUL D. CLEMENT
Deputy Solicitor General

GREGORY G. GARRE
Assistant to the Solicitor General

ANTHONY J. STEINMEYER
MARK S. DAVIES
Attorneys

Department of Justice
Washington, D.C. 20530-0001
(202) 514-2217

QUESTION PRESENTED

The United States will address the following question:

Whether and to what extent the Lanham Act, 15 U.S.C. 1125(a), prevents the uncredited copying of a work.

TABLE OF CONTENTS

	Page
Interest of the United States	1
Statement	2
Summary of argument	5
Argument:	
The Lanham Act prohibits false or misleading designations that are likely to cause confusion as to the source of goods, but does not establish an independent duty to credit the original creators of works	7
A. The creators of original works that qualify for a copyright or patent enjoy extraordinary protections during the life of the copyright or patent	7
B. The Lanham Act is focused on protecting consumers against confusion as to the source of goods and was designed to prevent direct passing off	11
C. Although the Lanham Act has been applied to claims of reverse passing off, it does not establish a generalized duty to credit a work's original creator	13
D. Other considerations also caution against overextending the Lanham Act in this context	19
E. The court of appeals' Lanham Act analysis in this case is fundamentally flawed	24
Conclusion	30
Appendix	1a

TABLE OF AUTHORITIES

Cases:	Page
Agee v. *Paramount Communications, Inc.*, 59 F.3d 317 (2d Cir. 1995)	27
Arrow United Indus., Inc. v. *Hugh Richards, Inc.*, 678 F.2d 410 (2d Cir. 1982)	16
Attia v. *Society of the New York Hosp.*, 201 F.3d 50 (2d Cir. 1999), cert. denied, 531 U.S. 843 (2000)	21
Barbeque Marx, Inc. v. *551 Ogden, Inc.*, 235 F.3d 1041 (7th Cir. 2000)	27
Batiste v. *Island Records, Inc.*, 179 F.3d 217 (5th Cir. 1999), cert. denied, 528 U.S. 1076 (2000)	27
Blinded Veterans Ass'n v. *Blinded American Veterans Found.*, 872 F.2d 1035 (D.C. Cir. 1989)	27, 28
Bonito Boats, Inc. v. *Thunder Craft Boats, Inc.*, 489 U.S. 141 (1989)	7, 8, 20
Cleary v. *News Corp.*, 20 F.3d 1255 (9th Cir. 1994)	17
College Sav. Bank v. *Florida Prepaid Postsecondary Educ. Expense Bd.*, 527 U.S. 666 (1999)	29
Compco Corp. v. *Day-Bright Lighting, Inc.*, 376 U.S. 234 (1964)	20
Cooper Indus., Inc. v. *Leatherman Tool Group, Inc.*, 532 U.S. 424 (2001)	17
Eldred v. *Ashcroft*, No. 01-618 (Jan. 15, 2003)	2, 7, 8
F.E.L. Publ'ns, Ltd. v. *Catholic Bishop*, 214 U.S.P.Q. 409 (7th Cir.), cert. denied, 459 U.S. 859 (1982)	27
Feist Publ'ns, Inc. v. *Rural Tel. Serv. Co.*, 499 U.S. 340 (1991)	18, 25
FTC v. *Indiana Fed'n of Dentists*, 476 U.S. 447 (1986)	13
G. Ricordi & Co. v. *Haendler*, 194 F.2d 914 (2d Cir. 1952)	8, 20
Gilliam v. *American Broad. Cos.*, 538 F.2d 14 (2d Cir. 1976)	22

Cases—Continued:	Page
Harper & Row Publishers, Inc. v. *Nation Enters.*, 471 U.S. 539 (1985)	8
International Ass'n of Machinists v. *Winship Green Nursing Ctr.*, 103 F.3d 196 (1st Cir. 1996)	27
International News Serv. v. *Associated Press*, 248 U.S. 215 (1918)	29
Inwood Labs., Inc. v. *Ives Labs., Inc.*, 456 U.S. 844 (1982)	11
Kellogg Co. v. *National Biscuit Co.*, 305 U.S. 111 (1938)	20
Kennedy v. *National Juvenile Detention Ass'n*, 187 F.3d 690 (7th Cir. 1999), cert. denied, 528 U.S. 1159 (2000)	19
King v. *Ames*, 179 F.3d 370 (5th Cir. 1999)	27
LaMothe v. *Atlantic Recording Corp.*, 847 F.2d 1403 (9th Cir. 1988)	
Lipscher v. *LPR Publ'ns, Inc.*, 266 F.3d 1305 (11th Cir. 2001)	27
Murray Hill Publ'ns, Inc. v. *ABC Communications, Inc.*, 264 F.3d 622 (6th Cir. 2001)	27
O. & W. Thum Co. v. *Dickenson*, 245 F. 609 (6th Cir. 1917), cert. denied, 246 U.S. 664 (1918)	12
Pennock v. *Dialogue*, 27 U.S. (2 Pet.) 1 (1829)	18
Peralta v. *Heights Med. Ctr., Inc.*, 485 U.S. 80 (1988)	29
Percy v. *Truefitt*, 6 Beav. 66 (Eng. 1842)	12
Polaroid Corp. v. *Polaroid Elecs. Corp.*, 287 F.2d 492 (2d Cir.), cert. denied, 368 U.S. 820 (1961)	27
Qualitex Co. v. *Jacobson Prods. Co.*, 514 U.S. 159 (1995)	11, 12, 21, 24
Roho, Inc. v. *Marquis*, 902 F.2d 356 (5th Cir. 1990)	17
Sears, Roebuck & Co. v. *Stiffel Co.*, 376 U.S. 225 (1964)	20
Singer Mfg. Co. v. *June Mfg. Co.*, 163 U.S. 169 (1896)	20

Cases—Continued: Page

Smith v. *Montoro*, 648 F.2d 602 (9th Cir. 1981) 6, 10, 14, 15, 16
TrafFix Devices, Inc. v. *Marketing Displays, Inc.*, 532 U.S. 23 (2001) 8, 19, 20, 23
Truck Equip. Serv. Co. v. *Fruehauf Corp.*, 536 F.2d 1210 (8th Cir.), cert. denied, 429 U.S. 861 (1976) 17
Two Pesos, Inc. v. *Taco Cabana, Inc.*, 505 U.S. 763 (1992) 12, 24
Waldman Publ'g Corp. v. *Landoll, Inc.*, 43 F.3d 775 (2d Cir. 1994) 25
Wal-Mart Stores, Inc. v. *Samara Bros.*, 529 U.S. 205 (2000) 23
Web Printing Controls Co. v. *Oxy-Dry Corp.*, 906 F.2d 1202 (7th Cir. 1990) 16

Constitution, treaty, and statutes:

U.S. Const. Art. I, § 8, Cl. 8 7
Berne Convention for the Protection of Literary and Artistic Works, 828 U.N.T.S. 221 ..... 1, 9, 10
Berne Convention Implementation Act of 1988, Pub. L. No. 100-568, § 3, 102 Stat. 2853 ..... 1, 9, 10
Trademark Act of 1946 (Lanham Act), 15 U.S.C. 1050 *et seq.*:
§ 409(a), 15 U.S.C. 1122(a) 1
§ 43(a), 15 U.S.C. 1125(a) ..... *passim*
§ 43(a), 15 U.S.C. 1125(a) (1982) 11, 15, 2a
§ 43(a)(1), 15 U.S.C. 1125(a)(1) 15
§ 43(a)(1)(A), 15 U.S.C. 1125(a)(1)(A) ..... *passim*
§ 43(a)(1)(B), 15 U.S.C. 1125(a)(1)(B) 12, 13, 15, 15, 16, 17, 29, 1a
§ 43(a)(3), 15 U.S.C. 1125(a)(3) 23
§ 45, 15 U.S.C. 1127 24
Trademark Law Revision Act of 1988, Pub. L. No. 100-667, § 132, 102 Stat. 3946 12

Statutes—Continued: Page

Visual Artists Rights Act of 1990, Pub. L. No. 101-650, § 603(a), 104 Stat. 5128 21
17 U.S.C. 106A(a)(1)(A) 21, 2a
17 U.S.C. 106A(b) 21, 3a
17 U.S.C. 106A(d)(1) 22
17 U.S.C. 106A(e)(1) 21, 5a
15 U.S.C. 45(b) 13
17 U.S.C. 101 ..... 21, 25
17 U.S.C. 302 2
17 U.S.C. 305 8
17 U.S.C. 304 2
35 U.S.C. 154 8

Miscellaneous:

Leon H. Amdur, *Copyright Law and Practice* (1936) 8
John T. Cross, *Giving Credit Where Credit Is Due: Revisiting the Doctrine of Reverse Passing Off in Trademark Law*, 72 Wash. L. Rev. 709 (1997) ... 14, 16, 17, 28
H.R. Rep. No. 609, 100th Cong., 2d Sess. (1988) 9
J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* (2002):
Vol. 3 27
Vol. 4 ..... 12, 13, 18, 28
3 Melville B. Nimmer, *Nimmer on Copyright* (2002) 9, 19
Restatement (Third) of Unfair Competition (1995) 9, 13, 18, 27, 29
S. Rep. No. 1333, 79th Cong., 2d Sess. (1946) 11
S. Rep. No. 352, 100th Cong., 2d Sess. (1988) 10
S. Rep. No. 515, 100th Cong., 2d Sess. (1988) 12
The Implications, Both Domestic and International, of U.S. Adherence to the International Union for the Protection of Literary and Artistic Works, 1986: Hearings Before the Subcomm. on Patents, Copyrights and Trademarks of the Senate Comm. on the Judiciary, 99th Cong., 1st & 2d Sess. (1986) 10

In the Supreme Court of the United States

No. 02-428

DASTAR CORPORATION, PETITIONER

v.

TWENTIETH CENTURY FOX FILM CORPORATION, ET AL.

ON WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE NINTH CIRCUIT

BRIEF FOR THE UNITED STATES AS AMICUS CURIAE SUPPORTING PETITIONER

INTEREST OF THE UNITED STATES

This case concerns the circumstances in which the Trademark Act of 1946 (Lanham Act), 15 U.S.C. 1125(a), prevents the uncredited copying of a work. The United States has a strong interest in promoting the pro-competitive policies underlying the Nation's trademark and antitrust laws, and in preventing consumer confusion as to the source of goods or services. The United States also has a substantial interest in ensuring that domestic law is consistent with the United States' international obligations under the Berne Convention for the Protection of Literary and Artistic Works, 828 U.N.T.S. 221, to which the United States has acceded. See Berne Convention Implementation Act of 1988, Pub. L. No. 100-568, 102 Stat. 2853. In addition, the United States and its agencies are subject to suit under the Lanham Act. 15 U.S.C. 1122(a).

STATEMENT

1. In 1948, three and a half years after the German surrender at Reims, General Dwight D. Eisenhower completed *Crusade in Europe* (*Crusade*), his written account of the allied campaign in Europe during World War II. Doubleday published *Crusade* and registered it with the Copyright Office in 1948. Pet. App. 9a. Doubleday granted the exclusive television rights in the book to an affiliate of respondent Twentieth Century Fox Film Corporation (Fox). In 1949, Fox made a television series based on *Crusade*, and registered the series with the Copyright Office. *Id.* at 8a-10a.[1] In 1975, Doubleday renewed the copyright on the book as the "proprietor of copyright in a work made for hire." *Id.* at 9a. Fox, however, did not renew the copyright on the *Crusade* television series, Br. in Opp. 20-21 n.4, and that copyright expired in 1977.[2]

In 1988, Fox reacquired from Doubleday the television rights in Eisenhower's book, including the exclusive right to distribute the *Crusade* television series on video, and to sublicense others to do so. Pet. App. 10a. Through sublicenses, respondents SFM Entertainment (SFM) and New Line Home Video, Inc., acquired from Fox the exclusive rights to distribute the *Crusade* series on video. SFM obtained the negatives of the original television series and restored and repackaged the series on video. Respondents' *Crusade*

---

[1] Fox contracted with Time, Inc., to produce the television series. Pet. App. 25a, 43a. Time assigned its copyright in the series to Fox. *Id.* at 9a.

[2] The validity of Doubleday's renewed copyright in the book remains at issue in this litigation, and is not addressed by this brief. If Doubleday's renewed copyright on the book is determined to be valid, it will not expire for several decades (until 2043) due to Congress's determination to extend existing and renewed copyrights in 1978 and 1998. See 17 U.S.C. 302, 304, as amended; *Eldred* v. *Ashcroft*, No. 01-618 (Jan. 15, 2003), slip op. 3-5. If Fox had renewed its copyright on the *Crusade* television series, that copyright also would be in effect today and for decades more.

videos are a "direct reproduction" of the television series and bear the same title as that series. *Id.* at 11a, 12a. The videos credit New Line, SFM, "A March of Time Production By Arrangement with 20th Century Fox," and Eisenhower and his book. *Id.* at 11a.

In 1995, petitioner, anticipating renewed interest in World War II on the 50th anniversary of the war's end, released a competitive video series entitled *Campaigns in Europe* (*Campaigns*). To make *Campaigns*, petitioner purchased tapes of the original *Crusade* television series, copied them, and then edited the series. Pet. App. 13a, 45a; see J.A. 247a-248a. In revising the *Crusade* series, petitioner's director of video acquisitions, Lanny Tarter, substituted a new opening sequence, credit page, and final closing for those in the *Crusade* series; substituted 26 new chapter-title sequences (which corresponded to the chapter-title sequences in the *Crusade* series); removed references to and images of the book; moved the "recap" in *Crusade* to the beginning of *Campaigns* and retitled it as a "preview"; added music; and narrated chapter introductions written by petitioner. *Ibid.*; see Pet. C.A. Br. 26, 28. The *Campaigns* series is nearly an hour shorter than respondents' *Crusade* series, and has about 30 minutes of new footage. Pet. 5.

Petitioner manufactured and sold the set of *Campaigns* videotapes as its own good. The screen credits appearing on petitioner's *Campaigns* videos state "DASTAR CORP presents" and "an ENTERTAINMENT DISTRIBUTING Production," and list Norman Andersen, petitioner's president, as "executive producer"; Tarter as "producer"; and Barbara Kaye, Tarter's assistant, as "associate producer." Pet. App. 18a, 45a; see Supp. J.A. 1-9. Petitioner's *Campaigns* series makes no reference to the *Crusade* television series or Eisenhower's book. Pet. App. 18a. The packaging for the *Campaigns* videos similarly contains no reference to the *Crusade* television series, and states: "Produced and Distri-

buted by: Entertainment Distributing" (owned by petitioner). Supp. J.A. 28-29.

Petitioner sells its *Campaigns* video series to Sam's Club, Costco, Best Buy, and other retailers and mail-order companies for $25 per set, substantially less than the *Crusade* video series sold by respondents. Pet. App. 19a.

2. In 1998, respondents brought this action alleging that petitioner's sale of its *Campaigns* video series infringed Doubleday's copyright in Eisenhower's book and, by extension, their exclusive television rights in the book. Respondents later amended their complaint to claim that petitioner's sale of *Campaigns* "without proper credit" to the *Crusade* television series constitutes "reverse passing off" in violation of the Lanham Act, 15 U.S.C. 1125(a), and state unfair competition law. Pet. App. 31a. On cross-motions for summary judgment, the district court entered judgment for respondents on all three counts. *Id.* at 55a.

To prevail on their reverse passing off claim under the Lanham Act—the only claim at issue in this Court—the district court stated that respondents must show that petitioner's *Campaigns* series "is a 'bodily appropriation' of the television series," which the court defined as the "copying or unauthorized use of substantially the entire item." Pet. App. 25a-26a. The court found that *Campaigns* amounts to such a copy, and violates the Lanham Act due to petitioner's failure to credit *Crusade*, stating: "[petitioner's] failure to identify the television series and the Book is misleading to the public; it gives the false impression that the series contains only the work of those listed in the credits even though the television series was produced by Fox and Time and significant portions of the Book are used verbatim." *Id.* at 53a.

To remedy that violation, the court found that respondents are entitled to actual damages in the amount of lost sales and good will from petitioner's infringing conduct, as well as double petitioner's profits from the sale of *Campaigns*. Pet. App. 25a-26a. In addition, the court awarded damages and injunctive relief on respondents' copyright infringement claim. *Id.* at 22a-23a.

3. The court of appeals affirmed the judgment for respondents on the Lanham Act claim, but reversed as to the copyright claim and remanded. Pet. App. 1a-6a. With respect to the Lanham Act claim, the court reasoned that "[petitioner] copied substantially the entire *Crusade in Europe* series created by [Fox], labeled the resulting product with a different name and marketed it without attribution to Fox." *Id.* at 3a. The court rejected petitioner's argument that respondents were required to "make an independent showing that the series manufactured by [petitioner] resulted in consumer confusion," reasoning that petitioner's "'bodily appropriation' of Fox's original series is sufficient to establish the reverse passing off." *Id.* at 3a-4a.[3]

SUMMARY OF ARGUMENT

Federal law grants extraordinary protections to the owners of a patent or copyright to prevent the uncredited and credited copying of original works, but those protections are necessarily available only for limited terms. Once a copyright or patent expires and a work enters the public domain, federal law generally allows, indeed encourages, the copying of the work to promote competition, but not without limitation. The Lanham Act—the federal trademark law—protects consumers from confusion as to the source of goods and, in particular, establishes a federal remedy against the "false designation of origin" or "false or misleading description of fact" with respect to a good that is "likely to cause

---

[3] As to the copyright claim, the court of appeals concluded that a triable issue exists related to whether Doubleday properly renewed the copyright on the book in 1976. See Pet. App. 2a, 47a. The copyright issue is not before the Court, see Pet. i, but remains alive in this case.

confusion * * * as to the origin, sponsorship, or approval" of the good by another person. 15 U.S.C. 1125(a)(1)(A).

Section 43(a) of the Lanham Act was designed to prevent passing off, the classic example of unfair competition. But lower courts have concluded that Section 43(a) also applies to certain types of *reverse* passing off. For example, in one leading case, the court held that Section 43(a) was violated when the distributor of a movie misattributed the name of the star of the film in the movie's advertising and credits by replacing the name of the actor who starred in the film with the name of someone who did not even appear in it. *Smith* v. *Montoro*, 648 F.2d 602 (9th Cir. 1981). So too, courts have concluded that Section 43(a) prevents a producer from obtaining the goods manufactured by a competitor, obliterating the competitor's mark, and then relabeling and reselling the same goods as the producer's own. Although they fall outside the heartland of Lanham Act protections, such misattribution and relabeling cases can be squared with a careful textual analysis of Section 43(a).

At the same time, however, Section 43(a) should not be construed in a manner that would establish a generalized duty on the part of producers to credit the original creators of works. Such a construction could overextend the Lanham Act by giving the original creators of works a perpetual *trademark* right to prevent the uncredited copying of a work, even after the work is no longer subject to *copyright or patent* protection from such copying. In addition, Congress has shown that it knows how to legislate additional protections from uncredited copying, and in 1990 did so with respect to specific artistic works. Likewise, recognizing such a duty would invite Lanham Act litigation by creators who viewed attribution as an unwelcome sign of their "approval" or "sponsorship" (15 U.S.C. 1125(a)(1)(A)) of a competitor's copy, especially where, as here, the copy is an *edited* version of the original work.

This case does not match either of the misattribution or relabeling situations in which lower courts have applied Section 43(a), and the court of appeals failed to engage in any careful analysis of respondents' reverse passing off claim under Section 43(a)'s terms. Indeed, without identifying any specific misattribution made by petitioner as to the source of *Campaigns*, the court of appeals held that petitioner was liable under Section 43(a) for distributing *Campaigns* "*without* attribution to Fox." Pet. App. 3a (emphasis added). That is, the court of appeals treated this as a non-attribution case. In addition, the court of appeals *automatically* assumed the requisite confusion based solely on the fact that *Campaigns* is substantially copied from the *Crusades* series. But that analysis improperly disregards the textual requirements in Section 43(a)(1)(A), and all but establishes a blanket rule against the uncredited copying of works in the public domain. Accordingly, the decision below should not stand.

ARGUMENT

THE LANHAM ACT PROHIBITS FALSE OR MISLEADING DESIGNATIONS THAT ARE LIKELY TO CAUSE CONFUSION AS TO THE SOURCE OF GOODS, BUT DOES NOT ESTABLISH AN INDEPENDENT DUTY TO CREDIT THE ORIGINAL CREATORS OF WORKS

A. The Creators Of Original Works That Qualify For A Copyright Or Patent Enjoy Extraordinary Protections During The Life Of The Copyright Or Patent

1. The Nation's copyright and patent systems are built on a "carefully crafted bargain." *Bonito Boats, Inc.* v. *Thunder Craft Boats, Inc.*, 489 U.S. 141, 150-151 (1989); see *Eldred* v. *Ashcroft*, No. 01-618 (Jan. 15, 2003), slip op. at 24; U.S. Const. Art. I, § 8, Cl. 8. To encourage innovation, the copyright and patent laws grant the creators of works that

qualify for a patent or copyright an exclusive right to use and benefit from their works for a period of years. See 17 U.S.C. 301-305; 35 U.S.C. 154. During that period, copyright and patent holders are free to authorize others to copy and sell their works and, in doing so, may insist through contract on receiving specified attribution for such works. But on expiration of a patent or copyright, the creation inures to the public, which is generally entitled to copy it and profit from its use. See *TrafFix Devices, Inc.* v. *Marketing Displays, Inc.*, 532 U.S. 23, 29 (2001); *Harper & Row Publishers, Inc.* v. *Nation Enters.*, 471 U.S. 539, 545 (1985).[4]

The copying of works that enter the public domain is not always welcomed by creators who have grown accustomed to the limited patent or copyright monopoly on such works, but such copying often benefits consumers by promoting competition and reducing prices. Indeed, as this Court has observed, "imitation and refinement through imitation are both necessary to invention itself and the very lifeblood of a competitive economy." *Bonito Boats*, 489 U.S. at 146; see *TrafFix*, 532 U.S. at 29 ("Allowing competitors to copy will

[4] As the Court observed in *Eldred*, slip op. 24-25, copyright law does not entail the same *quid pro quo* as patent law, but it is nonetheless built on a similar construct. In *G. Ricordi & Co.* v. *Haendler*, 194 F.2d 914, 914-915 (2d Cir. 1952), for example, Judge Learned Hand explained that after the copyright on a book published by the plaintiff had expired the public was free to copy it and sell it. The work in *Haendler* contained the libretto and vocal and piano scores from Verdi's *Falstaff*. After the copyright had expired, the defendant published "substantially an exact copy of the plaintiff's [book], save for the interpolation in the libretto of passages from Shakespeare's play." *Id.* at 914. Judge Hand explained that this was proper under federal copyright law, and further rejected the argument that the sale of defendant's copy violated state unfair competition law, where defendant "gave notice that [the copy] was his product." *Id.* at 916. See also Leon H. Amdur, *Copyright Law and Practice* § 15, at 299-300 (1936) ("By the expiration of the copyright of the novel, * * * any person could make any use of the novel which he saw fit. He could copy it, or publish it, or make a play out of it.") (citation omitted).

have salutary effects in many instances."); Restatement (Third) of Unfair Competition, § 1 cmt. a (1995) (Restatement) ("Competition in the marketing of goods and services creates incentives to offer quality products at reasonable prices and fosters the general welfare by promoting the efficient allocation of economic resources.").

2. Copyright holders also are protected by laws that honor the Nation's international commitments. In 1989, the United States acceded to the Berne Convention for the Protection of Literary and Artistic Works, 828 U.N.T.S. 221; see Berne Convention Implementation Act of 1988, Pub. L. No. 100-568, 102 Stat. 2853 (BCIA). Article 6*bis* of the Convention provides in part:

> (1) Independently of the author's economic rights, and even after the transfer of the said rights, the author shall have the right to claim authorship of the work and to object to any distortion, mutilation or other modification of, or other derogatory action in relation to, the said work, which would be prejudicial to his honor * * *.

828 U.N.T.S. at 235. The article embodies the European concept of non-economic, "moral rights." H.R. Rep. No. 609, 100th Cong., 2d Sess. 33 (1988); see 3 Melville B. Nimmer & David Nimmer, *Nimmer on Copyright*, § 8D.01[A] (2002) (Nimmer).

In acceding to the Berne Convention, Congress carefully considered the United States' obligations under Article 6*bis* and concluded that the protections available under then-existing domestic law, including the Lanham Act, were sufficient to meet those obligations. See H.R. Rep. No. 609, *supra*, at 38 ("Based on a comparison of its laws with those of Berne member countries, and on the current status of Federal and State protections of the rights [embodied in Article 6*bis*], the Committee finds that current United States law meets the requirements of Article 6*bis*."); see *id.* at 34 n.66 ("[T]he totality of our law, including the common

law of torts, provides protection at a level sufficient to comply with the convention's [moral rights] requirements.") (quoting letter from Secretary of Commerce); S. Rep. No. 352, 100th Cong., 2d Sess. 9-10 (1988) (considering "various provisions of the Copyright Act and Lanham Act, various state statutes, and common law principles").[5]

Like domestic copyright law, the Berne Convention is limited in important respects. For example, as Congress made clear when it passed the BCIA, the Convention is "not self-executing under the Constitution and laws of the United States," and the United States' adherence to the Convention does "not expand or reduce any right of an author of a work * * * to claim authorship of the work" under existing domestic law. § 3, 102 Stat. at 2853; see 828 U.N.T.S. at 235 (Art. 6*bis*(3)). In addition, the Convention by its terms does not apply to works that have entered the public domain in their country of origin. See 828 U.N.T.S. at 251 (Art. 18(2)). While the Convention does not itself create enforceable private rights, it ensures that copyrighted works receive important protections in member states.

3. This case began as a copyright infringement action, and respondents' copyright claim is still alive. If respondents prevail on that claim, copyright law will enable them—for decades to come, see note 2, *supra*—to prevent petitioner from copying the *Crusade* television series, with

[5] In particular, the ad hoc working group advising Congress on the BCIA in 1988 pointed to the Ninth Circuit's decision in *Smith* v. *Montoro*, 648 F.2d 602 (9th Cir. 1981). See *The Implications, Both Domestic and International, of U.S. Adherence to the International Union for the Protection of Literary and Artistic Works, 1986: Hearings Before the Subcomm. on Patents, Copyrights and Trademarks of the Senate Comm. on the Judiciary*, 99th Cong., 1st & 2d Sess. (1986) (App. 424 n.23) ("*Smith* v. *Montoro* indicates, in dicta, that omission of an author's name from his work may constitute 'an implied reverse passing off' and thus violate section 43(a) of the Lanham Act.") (quoting report). As discussed in Part C, *infra*, the holding in *Montoro* is grounded in the Lanham Act.

or without attribution. But as this case comes to the Court, the question is not whether *copyright* law enables respondents to insist on attribution for the original *Crusade* series; it is whether federal *trademark* law—specifically, Section 43(a) of the Lanham Act—entitles respondents to such attribution. The court of appeals reversed and remanded respondents' copyright claim, but held that respondents nonetheless are entitled to judgment on their Lanham Act claim.

B. The Lanham Act Is Focused On Protecting Consumers Against Confusion As To The Source Of Goods And Was Designed To Prevent Direct Passing Off

Quite unlike copyright or patent law, the Lanham Act is not designed to reward innovation or encourage invention, but instead to protect the public from confusion as to the source of goods. See *Inwood Labs., Inc.* v. *Ives Labs., Inc.*, 456 U.S. 844, 854 n.14 (1982); S. Rep. No. 1333, 79th Cong., 2d Sess. 3 (1946). By preventing competitors from copying "a source-identifying mark," the Lanham Act "reduce[s] the customer's costs of shopping and making purchasing decisions." *Qualitex Co.* v. *Jacobson Prods. Co.*, 514 U.S. 159, 164-165 (1995) (quotation omitted). At the same time, by protecting such a source-identifying mark, the Lanham Act "helps assure a producer that it (and not an imitating competitor) will reap the financial, reputation-related rewards associated with a desirable product." *Id.* at 164.

As originally enacted, Section 43(a) of the Lanham Act, the provision relied on by respondents in this case, created a federal remedy against persons who used in commerce either "a false designation of origin, *or* any false description or representation" in connection with goods or services. 15 U.S.C. 1125(a) (1982) (emphasis added).[6] The provision codified "the related common-law torts of technical trademark

[6] The original and current versions of Section 43(a) are reprinted in the appendix to this brief.

infringement and passing off, which were causes of action for false descriptions or representations concerning a good's or service's source of production." *Two Pesos, Inc.* v. *Taco Cabana, Inc.*, 505 U.S. 763, 785 (1992) (Thomas, J., concurring) (citations omitted).

Passing off is the prototypical example of unfair competition and occurs where one producer attempts to sell his goods under the pretense that they are another's. See *O. & W. Thum Co.* v. *Dickinson*, 245 F. 609, 621 (6th Cir. 1917) ("The essence of unfair competition consists in palming off."), cert. denied, 246 U.S. 664 (1918); *Percy* v. *Truefitt*, 6 Beav. 66, 73 (Eng. 1842) ("A man is not to sell his own goods under the pretence that they are the goods of another man.") (Lord Langdale); 4 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* § 25:5, at 25-11 (2002) (McCarthy) (Passing off is "the classic form of trademark infringement."). A producer's attempt to palm off his goods as another's directly impedes the basic objectives of trademark law by deceiving consumers as to the source of goods, and permitting one producer to capitalize on another producer's name. See *Qualitex*, 514 U.S. at 164.

In 1988, Congress amended Section 43(a) to bring it into conformity with certain developments in trademark law. See Trademark Law Revision Act of 1988, Pub. L. No. 100-667, § 132, 102 Stat. 3946; S. Rep. No. 515, 100th Cong., 2d Sess. 40 (1988). As amended, Section 43(a) still covers any "false designation of origin" or "false or misleading description of fact" about a good or service used in commerce. 15 U.S.C. 1125(a)(1)(A). But in 1988, Congress added a new requirement—in subsection (a)(1)(A)—that to be actionable such a false or misleading designation must be "likely to cause confusion * * * as to the origin, sponsorship, or approval" of one person's goods by another person. 15 U.S.C. 1125(a)(1)(A). In addition, Congress added a new section—subsection (a)(1)(B)—creating liability for such a

false or misleading designation when it "misrepresents the nature, characteristics, qualities, or geographic orgin" of goods or services "in commercial advertising or promotion." 15 U.S.C. 1125(a)(1)(B); see 4 McCarthy § 27:10, at 27-19 to 27-21.[7]

C. Although The Lanham Act Has Been Applied To Claims Of Reverse Passing Off, It Does Not Establish A Generalized Duty To Credit A Work's Original Creator

This case does not present a typical Lanham Act claim involving passing off. Petitioner has marked the *Campaigns* series as its *own* good, and respondents' claim is that petitioner violated the Lanham Act by selling its videos *without* crediting the original *Crusade* television series. That kind of claim has been characterized as "reverse passing off"—*i.e.*, a producer's attempt to sell another's good as its own—and raises different considerations under the Lanham Act.

1. Unlike regular passing off, "reverse passing off does not directly threaten the reputation of another since by definition the misrepresentation acts to *sever* the actual producer's association with the goods or services marketed by the actor." Restatement § 5 cmt. a (emphasis added). In addition, reverse passing off may not create the immediate deception caused by passing off. As one commentator has explained, "[i]n a case of reverse passing off, * * * consumers assume that the product comes from the defendant. If defendant has no reputation for quality, a situation that is fairly common in the cases, consumers are not deceived be-

---

[7] Congress has established other measures to prevent unfair trade practices. In particular, the Federal Trade Commission Act gives the Federal Trade Commission (FTC) broad authority to take action whenever it believes that any person "has been or is using any unfair method of competition or unfair or deceptive act or practice in or affecting commerce." 15 U.S.C. 45(b); see *FTC* v. *Indiana Fed'n of Dentists*, 476 U.S. 447, 454 (1986). The FTC's authority to bring such a proceeding is not limited to trademark's focus on false designations as to a product's source.

cause they have no specific expectations concerning the quality of the product." John T. Cross, *Giving Credit Where Credit Is Due: Revisiting The Doctrine Of Reverse Passing Off In Trademark Law*, 72 Wash. L. Rev. 709, 755 (1997). But at the same time, reverse passing off may indirectly confuse consumers as to the actual source of goods and deprive producers of the goodwill that is associated with being known as the creator of a well-liked good, and therefore implicates the basic policies underlying the trademark law.

2. Although reverse passing off generally does not present the classic Lanham Act problems posed by direct passing off, lower courts have concluded that certain types of reverse passing off may be proscribed by Section 43(a).

a. *Smith* v. *Montoro*, 648 F.2d 602 (9th Cir. 1981), is a path marking case. In *Montoro*, an actor, Paul Smith, contracted to appear in a film and "receive star billing in the screen credits and advertising for the film." *Id.* at 603. Defendants obtained the rights to distribute the film, and "removed Smith's name and substituted the name of another actor, 'Bob Spencer,' in place of Smith's name in both the film credits and advertising material." *Ibid.* Smith brought suit alleging, *inter alia*, that defendants violated Section 43(a) of the Lanham Act "by affixing or using 'a false designation or representation,' *i.e.*, another actor's name in place of [Smith's], in connection with the movie's advertising and credits." *Id.* at 604. The Ninth Circuit agreed.

The Ninth Circuit recognized that the alleged infringement was not direct passing off, but reasoned that the Lanham Act covers "economic practices or conduct 'economically equivalent' to palming off," including in an appropriate case "reverse passing off." 648 F.2d at 605. As the court explained:

> As a matter of policy, such conduct, like traditional palming off, is wrongful because it involves an attempt to misappropriate or profit from another's talents and workmanship. Moreover, in reverse palming off cases, the originator of the misidentified product is involuntarily deprived of the goodwill that otherwise would stem from public knowledge of the true source of the satisfactory product. The ultimate purchaser (or viewer) is also deprived of knowing the true source of the product and may even be deceived into believing that it comes from a different source.

Id. at 606-607 (citations omitted).

The Ninth Circuit's holding in *Montoro* is grounded in the text of Section 43(a). As the court of appeals explained, "the Lanham Act explicitly condemn[ed] false designations or representations in connection with '*any* goods or *services.*'" 648 F.2d at 605; see 15 U.S.C. 1125(a) (1982). At the time that *Montoro* was decided, the Lanham Act did not require a plaintiff to show that replacing the star's name with an actor who did not appear in the film was "likely to cause confusion" *as to the "origin" of the film.* 15 U.S.C. 1125(a)(1)(A) (2000) (emphasis added). But the court in *Montoro* emphasized that a false designation about who starred in a film is likely to affect how moviegoers perceive the nature or attributes of the film. See 648 F.2d at 607 ("In the film industry, a particular actor's performance * * * may be the primary attraction for movie-goers," and "being accurately credited for films in which they have played would seem to be of critical importance in enabling actors to sell their 'services,' *i.e.*, their performances.").[8]

---

[8] The result in *Montoro* also fits under Section 43(a)(1)(B) of the Lanham Act, which was added in 1988 (seven years after *Montoro*). That subsection is not limited to false designations as to *origin* and instead prohibits a producer from making a "false or misleading description of fact * * * in commercial advertising or promotion" as to a good's "nature, characteristics, qualities, or geographic origin." 15 U.S.C. 1125(a)(1)(B). The Lanham Act claim in *Montoro* was specifically aimed at "the movie's advertising and credits," 648 F.2d at 604, and advertising an actor who

b. Another class of reverse passing off cases in which the lower courts have applied the Lanham Act involves the relabeling and resale of goods manufactured by another producer as the defendant's own goods. For example, in *Web Printing Controls Co.* v. *Oxy-Dry Corp.*, 906 F.2d 1202 (7th Cir. 1990), Oxy-Dry purchased high-tech printing equipment from Web Printing and then resold the equipment. Before reselling the equipment, Oxy-Dry "obliterated, hid, or otherwise confused [Web Printing's] trademark" and thus "claim[ed] credit for the quality of [Web Printing's] products." *Id.* at 1203. The courts concluded that Oxy-Dry violated Section 43(a) by falsely labeling and passing off Web Printing's products as its own in a manner that was likely to deceive consumers as to the source of the goods. *Id.* at 1204 & n.2; see *Montoro*, 648 F.2d at 606 & n.5 (discussing relabeling cases); *Arrow United Indus., Inc.* v. *Hugh Richards, Inc.*, 678 F.2d 410, 416 (2d Cir. 1982).[9]

That conclusion, too, comports with the text of Section 43(a). When *A* acquires a good manufactured by his competitor, *B*, obliterates *B*'s label, and puts *A*'s own label on the good, *A* has made a "false designation of origin" or "false or misleading description of fact" as to the source of the good—the good was manufactured by *B*, not *A*. See Cross, *supra*, at 723 ("If defendant acquires a product originally manufactured by plaintiff and merely resells it as its own, it

---

does not appear in a movie as the movie's star misrepresents the movie's "nature, characteristics, [or] qualities" (Section 43(a)(1)(B)).

[9] In some of the relabeling cases, the competitor makes slight changes to the plaintiff's product before scraping off the plaintiff's mark and affixing its own mark on the good. In *Arrow United*, for example, the competitor slightly altered the size of the product—an "Arrow-Foil" damper used to regulate air flow. 678 F.2d at 415. Nevertheless, the court of appeals concluded that the plaintiff was entitled to preliminary relief under Section 43(a) of the Lanham Act after showing that the defendant had simply put its own label on the plaintiff's product because it was incapable of producing the product itself. *Id.* at 415-416.

is clear that plaintiff is the 'origin,' at least in the absolute sense of the word."); *id.* at 722 nn.63 & 64 (citing cases). At the same time, by simply relabeling *B*'s product as *A*'s own, *A* is likely to confuse or deceive consumers as to the source of its goods, which were manufactured by *B*.

c. In other cases, however, courts have rejected reverse passing off claims under the Lanham Act where, even though a producer began with a competitor's product, it manufactured its own good before attaching its label to it. In *Roho, Inc.* v. *Marquis*, 902 F.2d 356, 357 (5th Cir. 1990), for example, the defendant used cushions made by the plaintiff to create a "therapeutic mattress." The plaintiff argued that because defendant had produced only "a slightly modified version of [its] mattress, which [the defendant] sold under his own label, he has violated section 43(a)." *Id.* at 359. But in rejecting that "reverse palming off" claim, the court of appeals reasoned that, regardless of the "similarity" in the two products, the defendant had "actually created" a "new product" through its "[own] efforts." *Id.* at 360-361.[10]

To be clear, not only does the Lanham Act not *prevent* the sort of imitation in *Roho*, but the Nation's intellectual property laws *encourage* that kind of imitation in order to promote competition and innovation. When an existing work is copied and refined, a good is often improved and value is added to the economy. As Justice Story observed long ago,

---

[10] Another kind of reverse passing off that courts have found actionable under Section 43(a) occurs where a producer uses a photograph of a competitor's product to advertise or promote its own good. See, *e.g.*, *Cooper Indus., Inc.* v. *Leatherman Tool Group, Inc.*, 532 U.S. 424, 428 (2001) (defendant retouched photograph of plaintiff's pocket survival tool and removed trademark and then labeled photograph as defendant's own pocket tool in marketing materials and catalogues); *Truck Equip. Serv. Co.* v. *Fruehauf Corp.*, 536 F.2d 1210, 1216 (8th Cir.) (farm equipment manufacturer labeled photograph of competitor's grain trailer as its own in manufacturer's sales literature), cert. denied, 429 U.S. 861 (1976). Today, that kind of reverse passing off is addressed by Section 43(a)(1)(B).

the "best" way to promote the progress of useful arts is "by giving the public at large a right to make, construct, use, and vend the thing invented, at as early a period as possible." *Pennock* v. *Dialogue*, 27 U.S. (2 Pet.) 1, 19 (1829); cf. *Feist Publ'ns, Inc.* v. *Rural Tel. Serv. Co.*, 499 U.S. 340, 349-350 (1991). That public right, perhaps as much as any other factor, explains the unparalleled progress and ingenuity of American science and arts.

3. As the foregoing case law illustrates, reverse passing off may be actionable under Section 43(a) of the Lanham Act. But at the same time, because Section 43(a) was designed to prevent *direct* passing off—and thus eliminate the acute confusion such passing off creates as to the source of goods—in considering claims for *reverse* passing off under the Lanham Act courts should be diligent in ensuring that the requirements of Section 43(a) are met. That is especially true when a Lanham Act claim for reverse passing off does not involve a *mis*attribution of credit, as in *Montoro*, or the relabeling and resale of goods that were actually manufactured by another competitor, as in *Oxy-Dry Corp.*

Furthermore, courts should be cognizant that Section 43(a) of the Lanham Act was not intended to establish an independent duty on the part of a producer who copies a work within the public domain to identify the work's original creator. See *Cleary* v. *News Corp.*, 30 F.3d 1255, 1260 (9th Cir. 1994) ("[T]he case law does suggest that the Lanham Act does not create a duty of express attribution, but does protect against misattribution."); Restatement § 5, Reporters' Note cmt. b ("The case law does not recognize an affirmative duty on the part of a seller to disclose the identity of the manufacturer or producer of goods offered for sale; liability is imposed only on the basis of an express or implied misrepresentation that the goods have been produced by the actor or a third person.") (citing cases); 4 McCarthy § 27:85, at 27-156 to 27-157 ("[*Montoro*] holds only

that *mis-attribution* violates § 43(a), not that the mere removal of a credit created falsity and not that every actor and everyone that worked on a film is entitled under § 43(a) to receive screen credit.") (emphasis added).[11]

As a result, in a typical case, a producer who copies a work that is in the public domain, manufactures its own copy or refinement of the work, and clearly marks the copy as its own good, does not violate Section 43(a) simply by failing to credit the original creator of the underlying work.

D. Other Considerations Also Caution Against Over-extending The Lanham Act In This Context

Several additional considerations counsel against construing Section 43(a) of the Lanham Act in a manner that would establish a generalized duty on the part of producers to identify the original creators of works that have entered the public domain.

1. In construing the Lanham Act, this Court has been "careful to caution against misuse or over-extension" of the trademark protection into areas traditionally occupied by patent or copyright. *TrafFix*, 532 U.S. at 29; see *id.* at 34 ("The Lanham Act does not exist to reward manufacturers for their innovation in creating a particular device; that is the purpose of the patent law and its period of exclusivity."). As discussed above, while the patent and copyright laws grant creators substantial rights to prevent the copying of their works (whether credited or uncredited) for limited terms, the Court has repeatedly affirmed the public's right to copy

---

[11] See also, *e.g.*, *Kennedy* v. *National Juvenile Detention Ass'n*, 187 F.3d 690, 696 (7th Cir. 1999) ("[I]t is generally accepted that an author who sells or licenses his work, absent an express provision in a contract, does not have an inherent right to be credited as the author of the work.") (distinguishing *Montoro*), cert. denied, 528 U.S. 1159 (2000); 3 Nimmer § 8D.03[A][1] (The general rule is that outside of copyright or contract, an author does not have a right of attribution for its work).

works once they have entered the public domain. See *id.* at 32; *Bonito Boats*, 489 U.S. at 150-151.[12]

To be sure, the Court also has emphasized that the public's right to copy such goods is conditioned by laws, such as the Lanham Act, designed to "'protect businesses in the use of their trademarks, labels, or distinctive dress in the packaging of goods so as to prevent others, by imitating such markings, from misleading purchasers as to the source of the goods.'" *Bonito Boats*, 489 U.S. at 154; see *id.* at 166. But in discussing such trademark protection, the Court has focused on the obligation of a competitor who copies another's good to identify the copy as *its own product* (*i.e.*, to prevent passing off), and not necessarily to identify the good's *original creator*. See, *e.g.*, *Kellogg Co.* v. *National Biscuit Co.*, 305 U.S. 111, 120-121 (1938) (Kellogg "was free to use the pillow-shaped form, subject only to the obligation to identify its product lest it be mistaken for that of the plaintiff," which Kellogg did by selling its good in packaging that "bear[s] prominently the Kellogg name").[13]

---

[12] See, *e.g.*, *Sears, Roebuck & Co.* v. *Stiffel Co.*, 376 U.S. 225, 232-233 (1964); *Compco Corp.* v. *Day-Brite Lighting, Inc.*, 376 U.S. 234, 237 (1964); *Kellogg Co.* v. *National Biscuit Co.*, 305 U.S. 111, 119-120 (1938); *Singer Mfg. Co.* v. *June Mfg. Co.*, 163 U.S. 169, 185 (1896); see also *G. Ricordi & Co.*, 194 F.2d at 914-915, discussed in note 4, *supra*.

[13] Thus, for example, there was no suggestion in the recent *TrafFix* case that TrafFix's ability to copy MDI's dual-spring sign stand after the patent on that sign stand expired was subject to any requirement under the Lanham Act that TrafFix put a label on its sign stands specifically crediting MDI, or for that matter the device's inventor, Robert Sarkisian, as the original creator of its dual-spring sign stand. At the same time, MDI could—and did—invoke the Lanham Act to prevent TrafFix from selling its sign stands with a name (WindBuster) that was confusingly similar to MDI's (WindMaster). 532 U.S. at 26. Protecting against the use of a confusingly similar mark—and not imposing a duty on producers to credit the original creator of a work—is the way in which the Lanham Act has traditionally been invoked.

In deciding this case, the Court should avoid construing the Lanham Act in a manner that would enable creators to extend in perpetuity the protections available to creators for only a limited time under the patent and copyright laws, including the ability of a patent or copyright owner to prevent the uncredited copying of a registered work. Cf. *Qualitex*, 514 U.S. at 164 ("It is the province of patent law, not trademark law, to encourage innovation by granting inventors a monopoly over new product designs or functions for a limited time, * * * after which competitors are free to use the innovation.") (citations omitted); *Attia* v. *Society of the New York Hosp.*, 201 F.3d 50, 59 (2d Cir. 1999), cert. denied, 531 U.S. 843 (2000). Indeed, respondents initiated this action under the Copyright Act and, while they may prevail on their copyright claim based on the *book*, they could have readily prevented petitioner from distributing its *Campaigns* series if Fox had not allowed the copyright on the *Crusade* television series to expire in 1977.

2. Nor is there any reason to read into the Lanham Act a specialized right of attribution for the authors of *artistic* works. Congress knows how to establish such rights when it wants to. In 1990, Congress passed the Visual Artists Rights Act (VARA), Pub. L. No. 101-650, § 603(a), 104 Stat. 5128, which, *inter alia*, provides that the authors of certain artistic works "shall have the right * * * to claim authorship of that work." 17 U.S.C. 106A(a)(1)(A). But that explicit right of attribution is carefully limited. First, the right attaches only to specified "work[s] of visual art," such as paintings, sculptures, and photographs. 17 U.S.C. 101.[14] Second, the right is personal to the artist. 17 U.S.C. 106A(b) and (e). Third, the right only endures for "the life of the

---

[14] Among other things, the Act's definition of "work of visual art" specifically excludes books, motion pictures and audiovisual works, and works for hire. 17 U.S.C. 101. As a result, the Act has no application to the type of work at issue in this case.

author." 17 U.S.C. 106A(d)(1). Recognizing in Section 43(a) of the Lanham Act an independent duty on the part of producers to credit the creators of original works would all but render superfluous VARA's carefully crafted right of attribution with respect to only *specific* works.

3. Adopting a generalized rule requiring producers who copy works in the public domain to identify a work's original creator also could spark Lanham Act litigation over claims of improper approval or endorsement. Section 43(a) of the Lanham Act prohibits not only false or misleading designations as to origin, but false or misleading designations of fact that are likely to cause confusion as to the "sponsorship" or "approval" of a good by another person. 15 U.S.C. 1125(a)(1)(A). While some original creators may seek attribution from copiers, others may view such attribution as an unwelcome sign that they sponsor or approve of a competitor's copy. That is especially true in a case, such as this, where an original work has been altered by a competitor. See, *e.g.*, *Gilliam* v. *American Broad. Cos.*, 538 F.2d 14, 24 (2d Cir. 1976).

At the same time, interpreting the Lanham Act to establish a generalized right of attribution would require the courts to develop a new body of case law over what form or detail such attribution must take. In *Gilliam*, for example, the court debated whether the Lanham Act would be satisfied if defendants had aired a legend at the beginning of an edited broadcast of *Monty Python's Flying Circus* stating that Monty Python did not endorse the edited work, or whether such a legend would have to run during the entire broadcast. See *id.* at 25 n.13; *id.* 27 n.1 (Gurfein, J., concurring); cf. *Lamothe* v. *Atlantic Recording Corp.*, 847 F.2d 1403, 1408 (9th Cir. 1988) (partial attribution with respect to songs). The copyright laws avoid that problem by leaving to copyright holders for the duration of a copyright the discretion to determine whether—and, if so, on what terms—to license copying of their works.

Such a regime would create a Catch-22. On the one hand, producers could face Lanham Act liability for *failing* to credit the original creators of works on which their lawful copies are based and, on the other hand, they could face liability for *furnishing* such credit when an original creator does not want it. Even the mere threat of such litigation could stifle competition by discouraging producers from copying and selling works in the public domain. Cf. *Wal-Mart Stores, Inc.* v. *Samara Bros.*, 529 U.S. 205, 214 (2000) ("Competition is deterred * * * not merely by successful suit but by the plausible threat of successful suit").

4. Finally, there are other protections under the Lanham Act to prevent against confusion when a producer copies a work in the public domain without crediting the original creator. The Lanham Act prevents a producer from selling his copy under a confusingly similar mark as the original work. See 15 U.S.C. 1125(a); *TrafFix*, 532 U.S. at 28. In addition, the Lanham Act prevents a producer from dressing his copy in a way that is confusingly similar to a competitor's design or packaging. See 15 U.S.C. 1125(a)(3); *Wal-Mart*, 529 U.S. at 209. Carefully policing the trademarks, or trade dress, used by producers who copy goods in the public domain is the conventional stuff of trademark law, and typically is sufficient to protect against consumer confusion as to a good's source. Requiring producers under the Lanham Act to go further and credit a good's original creator should be the exception and not the rule.[15]

---

[15] Of course, the original creators of works, or those with the exclusive rights to sell such works, also may engage in self-protection by advertising or promoting their goods as the "real thing," and thus distinguish their own goods from copies.

E. The Court Of Appeals' Lanham Act Analysis In This Case Is Fundamentally Flawed

1. The reverse passing off claim in this case does not fit into either of the categories discussed above in which courts have usually found violations of Section 43(a). Unlike the situation in *Montoro*, the court of appeals did not find that petitioner made any *mis*attribution about its *Campaigns* videos series; rather, the court relied on petitioner's distribution of the series "*without* attribution to Fox." Pet. App. 3a (emphasis added). That is, the court of appeals grounded its decision on a *lack* of attribution, not on a *mis*attribution. Likewise, petitioner did not simply purchase respondents' videos, obliterate respondents' label, and then put petitioner's own label on respondents' videos; rather, petitioner manufactured and refined its own copy, which it sells as its own good. The Lanham Act claim in this case accordingly merits careful review under Section 43(a)'s terms. The court of appeals in this case failed to engage in such an inquiry.

2. a. By identifying its *Campaign* video series as its own good, petitioner has not made a "false designation of origin" or "false or misleading description of fact" as to the "origin" of that good. 15 U.S.C. 1125(a)(1)(A). Section 43(a)'s use of "origin" has been read to include not simply geographic origin, but also "'origin of source or manufacture.'" *Two Pesos*, 505 U.S. at 779 (Stevens, J., concurring); *id.* at 785 (Thomas, J., concurring) ("source of production"); see *Qualitex*, 514 U.S. at 166 (a trademark "distinguishes a firm's goods and identifies their source"); 15 U.S.C. 1127 (a "trademark" is used "to identify and distinguish" one person's goods from the goods "manufactured or sold by others and to indicate the source of the goods"). Petitioner is the source of its *Campaigns* video series, and the place for consumers to go if they experience problems with that good. Petitioner produced and manufactures its *Campaigns* video series using its own video production and manufacturing

equipment. Indeed, the court of appeals itself recognized that *Campaigns* was "manufactured by [petitioner]." Pet. App. 3a.

The fact that the content of petitioner's *Campaigns* was substantially copied from the original *Crusade* television series does not alone compel the conclusion that petitioner misrepresented the "origin" of its video series. As discussed above, in creating its *Campaigns* series petitioner did alter the original *Crusade* television series in certain respects and, perhaps in the eyes of some viewers, even improved it. See p. 3, *supra*. Indeed, assuming petitioner did not infringe a valid copyright on the *Crusade* series, petitioner's selection and arrangement of new music, a new opening title sequence, movement of the recap to the beginning, and creation of a new final closing likely would be sufficient to establish it as the author of a derivative work that could itself qualify for copyright protection. See 17 U.S.C. 101; *Feist Publ'ns, Inc.*, 499 U.S. at 345-347; *Waldman Publ'g Corp.* v. *Landoll, Inc.*, 43 F.3d 775, 782 (2d Cir. 1994). When an edited copy of a creative work not subject to copyright satisfies the originality requirement for a derivative work, it hardly follows that a producer misrepresents the "origin" of such a derivative work by putting its own label on it.[16]

The court of appeals did not rely on the screen credits in the *Campaigns* videos. But, as discussed, petitioner and the listed employees were in fact responsible for the production of *Campaigns*. See p. 3, *supra*. The credits in this case, therefore, do not contain the sort of misattribution in *Montoro*. Moreover, names appearing in the screen credits of a movie—which often include a variety of individuals such as actors, directors, make-up artists, and costume designers—do not in ordinary parlance identify the "origin" of a good;

---

[16] Even respondents have tacitly acknowledged that petitioner "create[d]" *Campaigns* insofar as it copied and altered it. Resps. C.A. Br. 9 (discussing how petitioner "create[d] *Campaigns*").

they tend to identify the people who appeared in or contributed to a film. In addition, consumers deciding whether to purchase a video or buy a movie ticket are most likely to rely on a feature's advertising or promotion (including a video's packaging or label), and not on screen credits that are accessible only by viewing the feature.

In any event, in finding a violation of Section 43(a), the court of appeals relied exclusively on petitioner's distribution of *Campaigns* "without attribution to Fox." Pet. App. 3a. To the extent that the court believed that Section 43(a) establishes a freestanding right of attribution, the court was mistaken.[17]

b. Even when there is a false or misleading designation as to origin, Section 43(a)(1)(A) requires a plaintiff to show that such a designation was "likely to cause confusion * * * as to the origin" of the good. 15 U.S.C. 1125(a)(1)(A). The court of appeals automatically assumed that such a likelihood of confusion exists because petitioner's *Campaigns* series is a "substantial[]" copy—or "bodily appropriation"—of the original *Crusades* series. Pet. App. 3a. That was error.

In Lanham Act cases, courts typically determine likelihood of confusion by looking to a variety of factors, only *one*

[17] Interpreting Section 43(a)'s reference to "origin" to include any original creator of an artistic work would raise other problems. For example, in this case *Time*, not Fox, arguably created the original *Crusade* television series in an artistic sense. See note 1, *supra*. But the court of appeals held that *Fox*, not Time, was entitled to attribution. Fox held the initial copyright on the *Crusade* series. But interpreting the Lanham Act to require attribution for an original copyright holder would be even more problematic from the standpoint of overextending trademark law into the province of copyright law. In addition, the court of appeals' analysis reveals that imposing a generalized attribution requirement for *artistic* works could lead to disputes about precisely *who* is entitled to such attribution, especially in the case of a work, such as *Crusades*, to which many may have contributed in some part. Interpreting "origin" to mean the source or manufacturer of a good avoids these problems.

of which is the similarity of the products. See, *e.g.*, *Barbecue Marx, Inc.* v. *551 Ogden, Inc.*, 235 F.3d 1041, 1043-1044 (7th Cir. 2000) (listing factors); *International Ass'n of Machinists* v. *Winship Green Nursing Ctr.*, 103 F.3d 196, 201 (1st Cir. 1996); *Blinded Veterans Ass'n* v. *Blinded Am. Veterans Found.*, 872 F.2d 1035, 1043-1044 (D.C. Cir. 1989) (Ginsburg, J.); *Polaroid Corp.* v. *Polaroid Elecs. Corp.*, 287 F.2d 492, 495 (2d Cir.) (Friendly, J.), cert. denied, 368 U.S. 820 (1961); 3 McCarthy § 23:19, at 23-66 to 23-68. To establish a likelihood of confusion, a plaintiff must show that the allegedly infringing conduct is likely to "confound[] an appreciable number of reasonably prudent purchasers exercising ordinary care." *Winship Green Nursing Ctr.*, 103 F.3d at 201. "[C]onfusion resulting from the consuming public's carelessness, indifference, or ennui will not suffice." *Ibid.*

Moreover, courts have recognized that consumer confusion is an essential element of reverse passing off claims under Section 43(a). See, *e.g.*, *Lipscher* v. *LPR Publ'ns, Inc.*, 266 F.3d 1305, 1313 (11th Cir. 2001); *Murray Hill Publ'ns, Inc.* v. *ABC Communications, Inc.*, 264 F.3d 622, 634 (6th Cir. 2001); *King* v. *Ames*, 179 F.3d 370, 374-375 (5th Cir. 1999); *Batiste* v. *Island Records, Inc.*, 179 F.3d 217, 224-225 (5th Cir. 1999), cert. denied, 528 U.S. 1076 (2000); *Agee* v. *Paramount Communications, Inc.*, 59 F.3d 317, 327 (2d Cir. 1995); *F.E.L. Publ'ns, Ltd.* v. *Catholic Bishop*, 214 U.S.P.Q. (BNA) 409, 416-417 (7th Cir.), cert. denied, 459 U.S. 859 (1982).[18]

[18] As explained in the Restatement (§ 2 cmt. d), when a "representation is literally false, a court may conclude in the absence of credible evidence to the contrary that the representation is likely to deceive or mislead." But "[w]hen the tendency to deceive or mislead turns instead upon the *inferences* to be drawn from the representation or upon a choice among several possible interpretations, direct evidence of the meaning attached to the representation by the relevant audience may be necessary to establish a likelihood of deception." *Ibid.* (emphasis added). The alleged

In many cases, courts may determine likelihood of confusion without extensive evidentiary proceedings. But the court of appeals did not consider whether there was any evidence of consumer confusion as to the source of *Campaigns* apart from the fact that the *content* of the *Campaigns* videos was substantially similar to the content of the *Crusade* series. It did not consider, for example, whether there was any evidence as to the familiarity of typical consumers with the *Crusade* television series; the respective channels in which petitioner and respondents advertise and distribute their goods; or any actual confusion with respect to the origin of the *Crusade* television series. See 4 McCarthy § 23:2.1, at 23-12 (discussing types of confusion evidence).[19]

More fundamentally, assuming that the requisite confusion as to origin automatically exists under Section 43(a)(1)(A) whenever a producer has copied substantially, or entirely, a creative work in effect establishes a generalized right to attribution (and rule against uncredited copying) that is not supported by the text or history of the Lanham Act or the other considerations discussed above. Thus, even if the Court concludes that respondents have shown a false or misleading designation as to origin, the Court should remand for further consideration of whether the record supports a finding of likely confusion as to origin.

---

misrepresentation in this case at best falls into the category in which direct evidence is typically required.

[19] The need for such record evidence may be particularly important in cases, such as this, where the defendant sells goods at retail outlets known for selling copies of goods at discount prices. As one commentator has explained, "[i]n today's economy, with its vast distribution chains and large retailers, consumers are accustomed to buying goods that are produced by unknown people. Therefore, a defendant's use of its name or mark may not be interpreted as an indication of origin." Cross, *supra*, at 753. See also *Blinded Veterans*, 872 F.2d at 1045 (consumers' awareness of original mark may affect likelihood of confusion).

3. Even when a case does not fit within Section 43(a)(1)(A), there may still be concern about whether a producer's designation or representation about a good could mislead consumers in a matter that is material to their purchasing decision. Section 43(a)(1)(B) is not limited to false or misleading statements as to *origin*, but instead provides broader protections in the specific context of commercial advertising and promotion. As discussed, that subsection, which was added in 1988, applies to any "false or misleading description[s] of fact" that misrepresent "the nature, characteristics, [or] qualities" of a good in "commercial advertising or promotion." 15 U.S.C. 1125(a)(1)(B). Accordingly, in certain instances, Section 43(a)(1)(B) may provide a cause of action that is not available under subsection (a)(1)(A).

But in this case, respondents have not focused on any particular advertising or promotional practice of petitioner. Moreover, respondents have litigated their reverse passing off claim under Section 43(a)(1)(A), and thus neither the court of appeals nor the district court considered the application of Section 43(a)(1)(B) in this case. See Pet. App. 50a-51a n.4; J.A. 130a-131a. The Court's usual practice is to "deal with the case as it came here and affirm or reverse based on the ground relied on below." *Peralta* v. *Heights Med. Ctr., Inc.*, 485 U.S. 80, 86 (1988). There is no reason to do otherwise here.[20]

---

[20] In *International News Service* v. *Associated Press*, 248 U.S. 215 (1918), this Court held that a news service violated common law by "taking news bodily from the bulletin boards and early editions of [Associated Press] newspapers and selling it as its own" later that same day. *Id.* at 231. As this Court recently stated, "the unfair competition at issue in *International News Service* amounted to nothing short of theft of proprietary information." *College Sav. Bank* v. *Florida Prepaid Postsecondary Educ. Expense Bd.*, 527 U.S. 666, 674 (1999). *International News Services* has not been applied outside its "unusual circumstances." Restatement § 38 cmt. e. Respondents in this case have not relied on the common law

CONCLUSION

The judgment of the court of appeals should be reversed and the case remanded for further proceedings.

Respectfully submitted.

THEODORE B. OLSON
Solicitor General

ROBERT D. MCCALLUM, JR.
Assistant Attorney General

PAUL D. CLEMENT
Deputy Solicitor General

GREGORY G. GARRE
Assistant to the Solicitor General

ANTHONY J. STEINMEYER
MARK S. DAVIES
Attorneys

FEBRUARY 2003

---

rule of *International News Services*, and the case does not, in any event, shed light on the Lanham Act issue in this case.

APPENDIX

1. Section 43(a)(1) of Title 15, United States Code, provides:

§ 1125. False designations of origin, false descriptions, and dilution forbidden

(a) Civil action

(1) Any person who, on or in connection with any goods or services, or any container for goods, uses in commerce any word, term, name, symbol, or device, or any combination thereof, or any false designation of origin, false or misleading description of fact, or false or misleading representation of fact, which—

> (A) is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of such person with another person, or as to the origin, sponsorship, or approval of his or her goods, services, or commercial activities by another person, or
>
> (B) in commercial advertising or promotion, misrepresents the nature, characteristics, qualities, or geographic origin of his or her or another person's goods, services, or commercial activities,

shall be liable in a civil action by any person who believes that he or she is or is likely to be damaged by such act.

2. Section 43(a) of Title 15, United States Code (1982), provides:

§ 1125. False designations of origin and false descriptions forbidden

(a) Civil action

Any person who shall affix, apply, or annex, or use in connection with any goods or services, or any container or containers for goods, a false designation of origin, or any false description or representation, including words or other symbols tending falsely to describe or represent the same, and shall cause such goods or services to enter into commerce, and any person who shall with knowledge of the falsity of such designation of origin or description or representation cause or procure the same to be transported or used in commerce or deliver the same to any carrier to be transported or used, shall be liable to a civil action by any person doing business in the locality falsely indicated as that of origin or in the region in which said locality is situated, or by any person who believes that he is or is likely to be damaged by the use of any such false description or representation.

3. Section 106A of Title 17, United States Code provides:

§ 106A. Rights of certain authors to attribution and integrity

(a) RIGHTS OF ATTRIBUTION AND INTEGRITY.—Subject to Section 107 and independent of the exclusive rights provided in section 106, the author of a work of visual art—

(1) shall have the right—

(A) to claim authorship of that work, and

(B) to prevent the use of his or her name as the author of any work of visual art which he or she did not create;

(2) shall have the right to prevent the use of his or her name as the author of the work of visual art in the event of a distortion, mutilation, or other modification of the work which would be prejudicial to his or her honor or reputation; and

(3) subject to the limitations set forth in section 113(d), shall have the right—

(A) to prevent any intentional distortion, mutilation, or other modification of that work which would be prejudicial to his or her honor or reputation, and any intentional distortion, mutilation, or modification of that work is a violation of that right, and

(B) to prevent any destruction of a work of recognized stature, and any intentional or grossly negligent destruction of that work is a violation of that right.

(b) SCOPE AND EXERCISE OF RIGHTS.—Only the author of a work of visual art has the rights conferred by subsection (a) in that work, whether or not the author is the copyright owner. The authors of a joint work of visual art are coowners of the rights conferred by subsection (a) in that work.

(c) EXCEPTIONS.—(1) The modification of a work of visual art which is a result of the passage of time or the inherent nature of the materials is not a distortion, mutilation, or other modification described in subsection (a)(3)(A).

(2) The modification of a work of visual art which is the result of conservation, or of the public presentation, in-

cluding lighting and placement, of the work is not a destruction, distortion, mutilation, or other modification described in subsection (a)(3) unless the modification is caused by gross negligence.

(3) The rights described in paragraphs (1) and (2) of subsection (a) shall not apply to any reproduction, depiction, portrayal, or other use of a work in, upon, or in any connection with any item described in subparagraph (A) or (B) of the definition of "work of visual art" in section 101, and any such reproduction, depiction, portrayal, or other use of a work is not a destruction, distortion, mutilation, or other modification described in paragraph (3) of subsection (a).

(d) DURATION OF RIGHTS.—(1) With respect to works of visual art created on or after the effective date set forth in section 610(a) of the Visual Artists Rights Act of 1990, the rights conferred by subsection (a) shall endure for a term consisting of the life of the author.

(2) With respect to works of visual art created before the effective date set forth in section 610(a) of the Visual Artists Rights Act of 1990, but title to which has not, as of such effective date, been transferred from the author, the rights conferred by subsection (a) shall be coextensive with, and shall expire at the same time as, the rights conferred by section 106.

(3) In the case of a joint work prepared by two or more authors, the rights conferred by subsection (a) shall endure for a term consisting of the life of the last surviving author.

(4) All terms of the rights conferred by subsection (a) run to the end of the calendar year in which they would otherwise expire.

(e) TRANSFER AND WAIVER.—(1) The rights conferred by subsection (a) may not be transferred, but those rights may be waived if the author expressly agrees to such waiver in a written instrument signed by the author. Such instrument shall specifically identify the work, and uses of that work, to which the waiver applies, and the waiver shall apply only to the work and uses so identified. In the case of a joint work prepared by two or more authors, a waiver of rights under this paragraph made by one such author waives such rights for all such authors.

(2) Ownership of the rights conferred by subsection (a) with respect to a work of visual art is distinct from ownership of any copy of that work, or of a copyright or any exclusive right under a copyright in that work. Transfer of ownership of any copy of a work of visual art, or of a copyright or any exclusive right under a copyright, shall not constitute a waiver of the rights conferred by subsection (a). Except as may otherwise be agreed by the author in a written instrument signed by the author, a waiver of the rights conferred by subsection (a) with respect to a work of visual art shall not constitute a transfer of ownership of any copy of that work, or of ownership of a copyright or of any exclusive right under a copyright in that work.